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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/673,151

09/30/2003

Kurt A. Dobbins

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EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT

PAPER NUMBER

4172

NOTIFICATION DATE

DELIVERY MODE

01/24/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/673,151	<b>Applicant(s)</b> DOBBINS, KURT A.	
	<b>Examiner</b> Christopher C. Johns	<b>Art Unit</b> 4172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/21/2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

The Examiner thanks the applicant for the timely response, filed in an amendment on 21 November 2007. The included replacement drawings, specification amendments, and claim amendments are sufficient to overcome their respective objections. Claims 1 and 2 were amended, while claims 3-15 were added. Claims 1-15 are in condition for examination.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6, and 7 rejected under 35 U.S.C. 103(a) as being unpatentable over an article from InfoWorld, entitled "The e-music trap", published 18 August 2000 (hereafter referred to as Trap).

#### **As per claim 1, Trap discloses:**

- receiving a payment request from a content provider (see page 2, last section, "A place for intermediaries", paragraphs 1-3);
- receiving a first part of a content transmission in a peer-to-peer network, wherein the content is unprotected (the first part of the content transmission would be a confirmation that a user wishes to continue with the transmission, which would be unprotected by DRM or any similar methods (well known to those skilled in the art at the time of the invention), such as a webpage which asked the user to confirm a purchase. These pages are not typically protected until the user confirms that he wishes to purchase the item.

Trap does not explicitly disclose that the system operates over a peer-to-peer network. However, the entire reference discusses the fallout of the Napster and MP3.com lawsuits, which were peer-to-peer music sites. It then discusses potential

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solutions to the problem of copyright infringement on peer-to-peer music sites, as discussed above, by billing users to "their monthly Internet access bill" (see page 2, last section, "A place for intermediaries", paragraphs 1-3) so users could hook stereos "to the Net" and easily "download what [they] want". While the RioPort system discussed in the reference deals with connecting "online storefronts" with users, it would have been obvious to one skilled in the art at the time of the invention to apply the same methodology to peer-to-peer music systems, because of the evident attractiveness of such systems to users – see page 1, paragraph 1, first sentence);

- offering an option of billing the payment request to a subscriber's network access provider (see page 2, last section, "A place for intermediaries", paragraphs 1-3);
- receiving an indication of transport parameters in the peer-to-peer network, the indication being associated with the content of the content transmission (the indications would include how much to charge for the content, which would inherently be necessary for proper operation of the system in Trap – the user would have to know how much he would be charged for the file);
- receiving a second part of the content transmission in the peer-to-peer network, transmitting the second part of the content transmission in the peer-to-peer network in accordance with the transport parameters (see page 2, last section, "A place for intermediaries", paragraphs 1-3 – this portion sounds like the actual content that the user wishes to purchase).

**As per claim 2, Trap discloses:**

- a data receiver configured to receive a first part of a content transmission, and an indication of payment parameters required for exploiting that content of the content transmission in a peer-to-peer network (see page 2, last section, "A place for intermediaries", paragraphs 1-3. While not explicitly disclosed that a data receiver exists to receive the parts of the transmission, it would inherently be required to make the system described in Trap work properly.

Trap does not explicitly disclose that the system operates over a peer-to-peer network. However, the entire reference discusses the fallout of the Napster and MP3.com lawsuits, which were peer-to-peer music sites. It then discusses potential solutions to the problem of copyright infringement on peer-to-peer music sites, as discussed above, by billing users to "their monthly Internet access bill" (see page 2, last section, "A place for intermediaries", paragraphs 1-3) so users could hook stereos "to the Net" and easily "download what [they] want". While the RioPort system discussed in the reference deals with connecting "online storefronts" with users, it would have been obvious to one skilled in the art at the time of the invention to apply the same methodology to peer-to-peer music systems, because of the evident attractiveness of such systems to users – see page 1, paragraph 1, first sentence);

- a service logic for grouping the first part of the content transmission and subsequent parts of the content transmission as a communications flow in the peer-to-peer network (reunification of parts is inherent in the art of electronic communication);

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- a payment logic for determining the payment parameters of the content transmission in the peer-to-peer network according to the indication of payment parameters, wherein the payment logic offers the option of billing payment to a network access provider of a subscriber (see page 2, last section, "A place for intermediaries", paragraphs 1-3);
- a switching apparatus for transporting the first part and subsequent parts of the content transmission to a communications port according to the communications flow determined by the service logic in the peer-to-peer network (inherent in the art of electronic communication);
- a data transmitter to transmit a payment authorization request to a payment receiver (see page 2, last section, "A place for intermediaries", paragraphs 1-3. While not explicitly disclosed that a data transmitter exists to send payment authorization to payment receivers, it would inherently be required to make the system described in Trap work properly).

**As per claim 3, Trap discloses:**

- recognizing a transaction in a preferred transporter for transmitting the content transmission, and transmitting, from the preferred transporter, an offer to bill a network access provider to the subscriber (not explicitly stated by Trap, but would inherently be required to make the system described work properly – the customer would confirm that the customer's account with the network access provider should be billed for the transaction).

**As per claim 6, Trap discloses:**

- billing a subscriber for network access provider charges and for payment requests from a content provider (see page 2, last section, "A place for intermediaries", paragraphs 1-3).

**As per claim 7, Trap discloses:**

- receiving the payment request at a preferred transporter (see page 2, last section, "A place for intermediaries", paragraphs 1-3 – the intermediary is the transporter);
- interpreting a content tag of the content transmission, sending a request from the preferred transporter to a network access provider (the system described in Trap would inherently have to understand which type of file, who created it, who owns it, etc., in order to bill properly);
- identifying a subscriber (inherent in the art of electronic communication, this may be done using an identifier such as the IP address);
- billing the subscriber (see page 2, last section, "A place for intermediaries", paragraphs 1-3).

Claims 4, 5, and 8-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Trap, in view of Official Notice.

**As per claim 4, Trap discloses:**

- automatically authenticating a subscriber at the preferred transporter by using a machine address of the subscriber's modem and binding it to a particular instance of at least one selected from a group consisting of a dynamic IP address and an authenticated subscriber identifier (The Examiner takes Official Notice that it would have been obvious to one skilled in the art at the time of the invention to bind the machine address of the modem to the IP address and/of the subscriber identifier – this was done by many online services including CompuServe, AOL, and Genie when they billed for their “premium services”).

**As per claim 5, Trap discloses:**

- automatically authenticating a subscriber at the preferred transporter by using a machine address of the subscriber's modem and binding it to a particular instance of both a dynamic IP address and an authenticated subscriber identifier (The Examiner takes Official Notice that it would have been obvious to one skilled in the art at the time of the invention to bind the machine address of the modem to the IP address and/of the subscriber identifier – this was done by many online services including CompuServe, AOL, and Genie when they billed for their “premium services”).

**As per claim 8, Trap discloses:**

- wherein the content provider is an online merchant, and wherein the preferred transporter is capable of arbitrating between multiple online merchants, multiple payment gateways, and multiple network access providers (see page 2, last section, "A place for intermediaries", paragraphs 1-3. It is clear from Trap that RioPort offers multiple music retailers the ability to do business through their service. The Examiner takes Official Notice that it would have been obvious to one skilled in the art at the time of the invention to, given the ability to distinguish between merchants, have the ability to distinguish between network access providers and payment gateways).

**As per claim 9, Trap discloses:**

- billing for microtransactions (the system in Trap is easily used for microtransactions – the Examiner takes Official Notice that it would have been obvious to one skilled in the art at the time of the invention to use the system for microtransactions because of its consolidated billing system).

**As per claim 10, Trap discloses:**

- pre-establishing accounts for online merchants with a network access provider (The Examiner takes Official Notice that it would have been obvious to one skilled in the art at the time of the invention to pre-establish accounts with the customers, prior to allowing them to access materials).

**As per claim 11, Trap discloses:**

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- providing preferred transporter service to pre-established accounts (The Examiner takes Official Notice that it would have been obvious to one skilled in the art at the time of the invention to provide better preferential service to customers who had taken the time to explicitly sign up for the service, rather than waiting until a purchase was to be made).

**As per claim 12, Trap discloses:**

- automatically interacting with a database to authenticate content requestor information and to determine network access provider information (The Examiner takes Official Notice that it would have been obvious to one skilled in the art at the time of the invention to use a database to authenticate users of the service, in order to store user information, preferences, billing information, and usage information for the system in Trap);
- generating a bill for the content transmission with a payment server, wherein the server is one selected from a group consisting of a server associated with the content transmission and a payment server aggregation point (a bill is generated and “shows up on [the customer’s] phone bill, or [his] ISP bill”);
- automatically enforcing license requirements and business rule requirements including payment requirements for playback of the media content (Digital Rights Management being used in conjunction with music was obvious to one skilled in the art at the time of the invention).

**As per claim 13, Trap discloses:**

- aggregating generated bills, providing billing information to the network access provider in at least one of the formats from a group consisting of real time and periodic aggregated billing information (The Examiner takes Official Notice that it would have been obvious to one skilled in the art at the time of the invention to provide bills in either of those ways).

**As per claim 14, Trap discloses:**

- presenting the offer to bill the network access provider to the subscriber as at least one from a group consisting of the only payment option, the default payment option, and one of a plurality of payment options (The Examiner takes Official Notice that it would have been obvious to one skilled in the art at the time of the invention to offer multiple payment options, in order to attract a broader audience of customers. This is well-known in the art of selling items).

**As per claim 15, Trap discloses:**

- the transport parameters includes at least one from a group consisting of an exclusion of usage fees, an inclusion of usage fees, a byte cap restriction, the removal of a byte cap restriction, a decreased bandwidth, and an increased bandwidth (The Examiner takes Official Notice that it would have been obvious to one skilled in the art at the time of the invention to give away certain files – many services will give a certain number of free accesses, files, or otherwise, in order to

entice customers to use their service. This would be accomplished in Trap by sending the file with a “free” transport parameter. Additionally, the Ethernet protocol (well known to those skilled in the art at the time of the invention and used on computers that would implement both the Trap system and the instant application's system) has the ability to “negotiate” speeds to be used on links between two computers – see “Ethernet Autonegotiation”).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 and 2 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent Application 2002/0007350, by Yen, for on-demand data distribution in peer-to-peer networks. It involves payment and tracking, and allows for a centralized database of files.
- US Patent Application 2004/0181487, by Hanson, covering a “digital media clearing house platform” where a peer-to-peer network is involved, and payments are made to content owners and providing computers.
- “FairShare anti-piracy”, a posting from Halfbakery.com, where a peer-to-peer file sharing system is discussed, with payment options in mind.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is 571-270-3462. The examiner can normally be reached on Monday through Friday, 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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